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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/223,347	12/30/98	BIERRE	P P-4286

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IM62/0127

EXAMINER

KIM, J

ART UNIT	PAPER NUMBER
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1743

DATE MAILED:

01/27/00

5

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Office Action Summary

Application No.
09/223,347

Applicant(s)

Bierre et al.

Examiner

John C. Kim

Group Art Unit
1743



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-31 _____ is/are pending in the application.

Of the above, claim(s) 17-31 _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-31 _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Dec 30, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-16, drawn to a method of identifying a container, classified in class 436, subclass 165.
 - II. Claims 17-31, drawn to a uniquely identifiable container, classified in class 206, subclass 459.1 or class 422, subclass 915.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the process can be used to identify goods sold in retail stores.
3. During a telephone conversation with Ms. Nanette Thomas on January 6, 2000, a provisional election was made without traverse to prosecute the invention of I, claims 1-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 17-31 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

5. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Specification

6. The disclosure is objected to because of the following informalities:

On page 11, line 14, the reference number "24" describing a container should be --20--.

Appropriate correction is required.

7. The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

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Claim Objections

8. Claims 1-16 are objected to because of the following informalities:

In claim 1, the phrase "as part of its manufacture locating said biological sample in said container" is unclear. To obviate this objection, the examiner suggests placing --and-- or a comma after the word "manufacture."

Claims 5 and 8 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

To obviate these objections in claim 5 and 8, the examiner suggests changing the dependence from "claim 1" to --claim 2-- and "claim 6" to --claim 7--, respectively.

In claim 9, the word "adjacent" should be followed by the word --to--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1- 3, 7-11 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kavanaugh 5,683,786.

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Kavanaugh 5,683,786 teach identifying a biological sample container (microscope slide) comprising the steps of:

obtaining a container (slide 10) having an outer surface;
providing a container (slide 10) with a unique identifier where the specular reflectance differs and where the method of providing the identifier is by laser etching;
detecting and sensing light reflected by container (bar code scanner);
and associating the identifier with information pertaining to use or planned use of the container, as recited in instant invention (FIGS.3, 5-6; col. 1; line 66- col. 2, line 14; col. 3, lines 25-60).

Thus, claims 1- 3, 5, 7-11 and 16 are anticipated by Kavanaugh 5,683,786.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

13. Claims 1- 3, 7-11 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanaugh 5,683,786 in view of De Rossett, Jr. 4,985,115.

Kavanaugh 5,683,786 teach identifying a biological sample container (microscope slide) comprising the steps of:

obtaining a container (slide 10) having an outer surface;

providing a container (slide 10) with a unique identifier where the specular reflectance differs (specular reflectance of etching is less than adjacent areas) and where the method of providing the identifier is by laser etching;

detecting and sensing light reflected by container (bar code scanner);

and associating the identifier with information pertaining to use or planned use of the container, as recited in instant invention (FIGS.3, 5-6; col. 1; line 66- col. 2, line 14; col. 3, lines 25-60).

Kavanaugh 5,683,786 fails to teach where the specular reflectance is greater than adjacent areas.

De Rossett, Jr. 4,985,115 teaches highlighting etched glass by embedding the etching with epoxy for greater specular reflectance.

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It would have been obvious to one of ordinary skill in the art to apply the teachings of De Rossett, Jr. 4,985,115 to Kavanaugh 5,683,786 if unobstructed view is desired.

14. Claims 4-6, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kavanaugh 5,683,786 and De Rossett, Jr. 4,985,115 as applied to claim 1- 3, 7-11 and 16 above, and further in view of Handly 5,397,410 and Richman 5,801,356.

Both Kavanaugh 5,683,786 and De Rossett, Jr. 4,985,115 are silent about using alternative means for marking a container besides etching with a laser.

Handly 5,397,410 teaches providing an identifier by incorporating a ceramic film coating with a bar code pattern onto glassware.

Richman 5,801,356 teaches abrading as an alternative means to laser etching letters on glass.

It would have been obvious to one of ordinary skill in the art to apply the teachings of either Handly 5,397,410 or Richman 5,801,356 as a means of marking glassware because both are well known in the art as alternative means to the expensive and costly laser etching. It would have been also obvious to use melting as a means to engrave an identifier on a container if the container is plastic instead of glass.

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Conclusion

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner John C. Kim whose telephone number is (703) 306-5414.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Jill Warden, can be reached at (703) 308-4037. The fax number for the organization where this application or proceeding is assigned is (703) 305-7718.

JKIM

January 18, 2000


Jill Warden
Supervisory Patent Examiner
Technology Center 1700